

REMARKS

In the 16-Apr-2009 non-final office action:

- The specification was objected to under 35 USC 132 on the alleged grounds that the amendment filed on 10/26/2006 added new matter.
- Claims 1-2 and 4 were rejected under 35 USC 112, ¶ 2 for failing to comply with the written description requirement, on the alleged grounds that “[t]he disclosure as originally filed appear(ed) to require the presence of (three components) in the coating composition formulations I and II (see published application paragraph 0028-0029).”
- Claims 1-2 and 4 were rejected under 35 U.S.C. 103(a) as being unpatentable over Kyminas (USP 4,749,731) in view of Kadambande (USP 6,627,700) or Weinmann (USP 6,395,845) and also over Kadambande or Weinmann in view of Kyminas.
- Claims 21-26 were rejected under 35 USC 103(a) as being unpatentable over Wu (USP 3,997,694) or Wu (USP 3,943,187).
- Claims 22-25 were rejected under 35 USC 103(a) as being unpatentable over Wu (USP 3,997,694) or Wu (USP 3,943,187) as applied to Claim 21, and further in view of Christenson (USP 4,335,829).

Claims 1-2, 4 and 21-26, as amended, are being submitted for the Examiner’s consideration.

Amendments to the Specification

The specification has been amended to correct the term “Hapco NXZ” to –Nopco NXZ¹--. “Nopco NXZ” is a well-known defoamer/anti-foaming agent, as evidenced by

¹ A trademark search on TESS at the www.uspto.gov web site indicates that the word mark “NOPCO” is dead.

references to “Nopco NXZ” in 135 U.S. Patents issued in the years 1976 – 2003². Furthermore, the designation “NXZ” is well-known to those skilled in art of coatings, such as paints, and it is therefore submitted that one skilled in art would have understood “Hapco NXZ” as being “Nopco NXZ”.

Amendments to the Claims

Claims 1, 2 and 4 have been amended to recite that the coating material is “food grade”.

Claim 21 has been amended to clarify that the amount of calcined clay is non-zero.

Objection to the Specification

The Examiner’s objection to the specification, as set forth in the 16-Apr-2009 office action, is traversed. As far as the specification (i.e., not the claims) is concerned, the amendment of 10/26/2006 simply added the TM symbol to indicate that certain items were tradenames. It is submitted that this does not add new matter to the specification. Accordingly, this objection should be withdrawn.

Rejection of Claim 1, 2, & 4 under 35 USC 112,1

On page 8 of the 16-Apr-2009 Office Action, in response to Applicants’ earlier arguments about certain trademarked compounds, the Examiner stated:

Although Applicant argues that the function and/or general composition of NILSET™ 17, HAPCO™ NXZ and BORCHI™ GOL E2 are known in the art, generalized statements in Applicant’s arguments are not adequate, especially when such compounds are apparently highly region-specific. Such information should be present as objective evidence (e.g., in the form of declarations, product documentation, etc.) for the record.

² The present application was filed Dec 30, 2003. The 135 number is based on a full-text search of granted US patents at the USPTO web site. The first 50 of these patents are identified in an attachment to the present amendment.

Attached to this paper are the following documents, which provide product documentation or other evidence:

- (a) Product information for BorchTM Gol E2, taken from the web site of the manufacturer www.borchers.com. The document describes this compound as a “flow promoter”, which is consistent with the function of “flow control agent”, as explained in the amendment filed 16-August-2007.
- (b) Product information for NILSETTM 117, taken from a page of manufacturer Karo Chem Pvt. Ltd’s found on www.tradeinia.com. The document describes this compound as an “antisetling agent” which is consistent with the description of “anti-settling agent”, as explained in the amendment filed 16-August-2007.
- (c) A list of 50 of the 135 US patents issued between the years 1976 – 2003, which mention “Nopco NXZ”, a well known defoamer/anti-foaming agent, which is consistent with the function of “anti-foaming agent”, as explained in the amendment filed 16-August-2007.

In light of this objective evidence, it is submitted that the compounds mentioned in the specification would be understandable to one having ordinary skill in the art.

Rejection of Claim 1, 2, & 4 under 35 USC 103(b)

It is submitted that the cited prior art does not disclose a food grade coating material comprising the recited compounds.

Rejection of Claims 21-26

Claim 21 has been amended to recite that the amount of calcined clay is non-zero. It is submitted that neither Wu reference nor Christenson disclose a food-grade coating material comprising calcined clay and the remaining components recited in these claims.

Reconsideration of the application is requested. Claims 1, 2, 4, and 21-26 are believed to be in allowable form and define over the prior art of record. An early notice of allowance is therefore requested so that the application may proceed to issue.

If any fee is required, including extension of time fees and claims amendment fees, the Director is authorized to charge any such fee to Womble Carlyle's Deposit Account No. 09-0528.

Respectfully Submitted,

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Enclosures

Information re Borchl Gol E2
Information re Nilset 117
Information re Nopco NXZ